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EXAMINER

SMITHERS, MATTHEW

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/733,737
Filing Date: December 08, 2000
Appellant(s): ADIANO ET AL.

MAILED

AUG 09 2007

Technology Center 2100

James E. Boice
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 March 2006 appealing from the Office action mailed 26 August 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 10/26/2005 has not been entered.

(5) Summary of Claimed Subject Matter

The examiner disagrees with the summary of claimed subject matter contained in the brief.

Particularly noted is the absent of any recitation regarding "(3) permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded. " as recited in appellant's brief.

Appellant's only recitation regarding this feature may be found in his disclosure, on pages 3 and 7, where, it is described as a feature for preventing future or unauthorized additional installations. Forwarding or copying of a program for additional installation or execution, on subsequent computers or machines is prevented by the used mark that is recorded at the initial installation, see page 3, lines 10 et seq., and page 7, lines 9 et seq.. ***Marking of the installation script as used also disables the forwarding mechanism of the electronic mail software to prevent the user from accessing or installing a second copy of the installation script or software, (page 3, lines 12 et seq.).*** The specification only

appears to disable the running of the installation script and not the software application program. The application software is enabled and disabled via a value stored in the system's registry, as evidenced by appellant's disclosure reciting, "When the application is launched/ [operated or run], the hard drive serial number is read from the installation machine... and compared to the value stored in the system registry. If the serial numbers match, the application is allowed to execute normally. If they do not match, the application terminates. This prevents the application from being used even if the entire hard drive image is copied to another machine, (see page 3, lines 17 et seq.)." Thus, it is the registered value not the marking of the do not forward instruction that prevents the application software from being executed or run. [emphasis added]. It is the installation script that the do not forward instruction (or determination) prevents running, not the application program. The running of the application program is tied to the value stored in the register, which, is based upon the system's serial number not the do not forward instruction.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,584,564	OLKIN et al.	6-2003
6,721,784	LEONARD et al.	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: the final office action has been reproduced below. The remarks drawn to the advisory action are not subject to appeal, accordingly, they are deemed moot and will not be addressed by the examiner any further.

DETAILED ACTION

1. Claims 1-45 have been cancelled by an amendment filed 5/2/05.

Claim Objections

2. Applicant is advised that should claims (47 and 53), (60 and 54), (55 and 61), (56-57 and 62-63), be found allowable, said claims will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 46-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 46-48, the claim recite, "Permitting the software application to run...prevent the e-mail message ...from being forwarded..." As it is written it is unclear as to who or who is permitting the software application from being run or forwarded. There does not appear to be recitation as to who or who is making a determination or similarly processing the additional steps in claims 47-48. Similar deficiencies are believed to exist in claims 52-57.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. As understood in view of the 112 problems recited above, claims 46-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olkin et al., U.S. Pat. No. 6,584,564 and Leonard et al., U.S. Pat. No. 6,721,784, hereinafter respectively '564 and 784.

7. As per claims 46, '564 teach a method for secure electronic distribution of software media files (fig. 3 and col. 5, lines 42 et seq.) over networks comprising: e-mail as a delivery mechanism (abs., figs. 2b, 3, 5, 6a, col. 3, lines 30-45 et seq., appending

as an attachment/file/media/data/program (col. 14, lines 36 et seq.), e-mail message, opening, installing (figs. 3, 5, 8, col. 4, lines 17-25 et seq.), marking (fig. 6c) and storing said files on a receiving/recipients computer (fig. 6a-b, col. 4, lines 35 et seq.). It does not teach marking the e-mail as used to prevent further installations/desired events that is being forwarded.

8. '784 teach saving and marking media files to prevent disable further installations/events and being forwarded (figs. 4 and 5 respectively (220 and 330), fig. 12 (20), figs. 13 and 15, abs., figs. 3-8, col. 6, lines 20-35 et seq., col. 19, lines 25 et seq., and col. 20-21). '784 also use special handling instructions as part of the installation process, failure to follow these instruction results in either nullification of the installation process or termination/failure (col. 18, lines 16-40 et seq.). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the software distribution of '564, with a means of enabling and controlling the distribution of an electronically transmitted message, an e-mail attachment, as disclosed by '784. One of ordinary skill in the art would have been motivated to perform such a modification, because, one of ordinary skill in the art would have realized that the originator of a e-mail message might desire to control the distribution and viewing of the content of said e-mail data as a way of safe guarding the data against unauthorized use and/or distribution (col. 3, lines 50 et seq., and col. 6, lines 20 et seq., and col. 19-21). A person of ordinary skill in the art, desiring not to have a user exceed his authority to use or distribute an email and its data would have desire to implement a means of ensuring that the user and system afforded some means of preventing a specific

event/installation from occurring, i.e. forwarding. A skilled artisan with such a desire in mind would have viewed the invention of '784 as a means of adding access control and security features to the e-mail system, while still making the data readily available. The additional use and modification of the applets would have afforded the invention a greater degree of control and security.

9. As per claims 47, '564 teach permitting an application to run if it is from a pre-specified e-mail server. '564 teach that a security server 24 and an e-mail server 22 work co-operatively, under the control of an applet program, with a sender to generate a unique key and ID/data for an encrypted e-mail message. This key is utilized along with a password to ensure registration and authentication of a receiving computer. The receiving computer cannot run the program if it does not register with the security server and thus the email server, thereby preventing execution if the key and ID data determination data is missing. '784 similarly, teach using applets to control the execution and delivery of e-mail messages and attachments (see col. 19, lines 47 et seq., thru col. 21).

10. As per claim 48, the discontinuation of installation if unsaved is not explicitly taught. The examiner takes official notice of both the motive and modification necessary to have an applet discontinue installation if an application is not saved first/unsaved. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the invention of '564 and '784 to require that a computer determine whether an application has been saved, before allowing it to be installed. A person of ordinary skill in the art could have modified the java applet control program of

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'564 and '784 to require that an e-mail attachment/program must be saved or else it is preventing it from being installed. A person of ordinary skill in the art would have readily envisaged that e-mail attachments may have become compromised, corrupted or been exposed to a virus/worm. A person with such a desire in mind would have been motivated to have the attachment/program saved before exposing their entire system to its contents; moreover, if an attachment had become corrupted during the installation process, then there would be no way of recovering the lost data without first retransmission of the e-mail message. '564 provides for a myriad ways of installing e-mail attachments see figs. 3, 5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

11. Alternatively, the e-mail attachments are routinely received and stored in the inbox of a recipient's computer. System administrators conventionally require the saving of executable objects to a safe space such as a protected zone or a computer media before allowing installation on ones system. A person of ordinary skill in the art would have readily envisaged that e-mail attachments may have become compromised, corrupted or been exposed to a virus/worm. A person with such a desire in mind would have been motivated to have the attachment/program saved before exposing their entire system to its contents; moreover, if an attachment had become corrupted during the installation process, then there would be no way of recovering the lost data without first retransmission of the e-mail message. '564 provides for a myriad ways of installing e-mail attachments see figs. 3,5-8, col. 7, lines 55 thru, col. 8, lines 27 et seq.

12. As to claim 49, '564 allows imbedding instruction into the e-mail message, encrypting a serial number/receiver data, decrypting, and comparing with a

registry/security server of authorized users/system. The security server and mail server of '564 provides for a send secure feature. This feature requires that the receiving computer first register for the secure servers in order to obtain secure e-mail and their attachments. The applet then compares the information to verify the identity of the recipient/receiving computer (figs. 7-8, col. 6, lines 12-col. 7, lines 25 et seq.).

13. Alternatively, the encrypting of a serial number of the storage device in a registry, '784 require that specific processes and events are followed as part of the installation process, it does teach utilizing an encrypted form of the serial number as a part of registering process for installation. It does, however, teach that the installation data maybe stored either locally or remotely, see figs. 6, 9, and 16, and col. 16, lines 44 et seq.. The examiner takes official notice of both the motive and modification necessary for having a local processor store its identifying information/serial number/machine identity in an encrypted registry as part of a validation/installation process. '564 is being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et seq., and lines 60-67 et seq., col. 10, line 25 et seq. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the installation and verification processes of '784 with an applet subroutine as taught by '564, for enabling the installation and verification process to having a registry that has identifying information that is machine or computer specific and dependent. One of ordinary skill in the art would have been motivated to perform this modification, because, one would have had a desire to ensure, that after supplying a secured e-mail or application, that the data or program was not inappropriately stored or used on a machine for which it

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was not intended. A person of ordinary skill would have chosen this or any other well proven method of protecting data as a means of providing additional steps in protecting their data or program, as suggest by "784 at abs., col. 1, lines 20-45, col. 3, lines 50 et seq., and col. 6, lines 20-34. '564 also indicates that the user may have various installable options associated with an applet to permit registration, see '564 at col. 4, lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq.

14. As to claims 50-51, the enabling of an authorized user identifier/password, and installing only once, co-operatively the single use key, read only once install each use, see '564 figs. 3, 6a-c, col. 7, lines 8 et seq., and col. 8, lines 15 et seq.

15. As to claims 52-63 recite the concomitant elements of claims 46-51, accordingly they are rejected under the same rationale. See above for the specifics of the rejections.

16. As per claims 64-69, they differ from rejected claims 46-64 by reciting a system for carrying out the process steps of the method claims. '564 provides a system having a means for appending, transmitting, receiving computer, permitting applications to run, a specified e-mail server (collectively 22 and 24), means for embedding, receiving encrypted, means for decryption, means for comparing, means for enabling/halting, hardware/system with accompanying functions as recited above (fig. 1, sender, receiver, e-mail server, security server, fig. 3, figs. 7-8 and col.5, lines 29 et seq.).

17. As per claims 70-75, they differ from rejected claims 45-69, by reciting a machine-readable medium having a plurality of instructions embodied therein. '564

teaches embodying his invention in the form of software modules see fig.4, and col. 5, lines 40 et seq., col. 6, lines 12 et seq., col. 7, lines 54 et seq., col. 8, lines 15 et seq.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman Wright whose telephone number is (751) 272-3844. The examiner can normally be reached on Mondays - Thursdays from 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

(10) Response to Argument

Appellant remarks that the 112 rejection of claims 46-52 is improper because permitting the software application to run is clear and definite, the examiner does not agree. As the claims are understood and written, it is unclear as to who or whom is permitting the software application from being run or forwarded. There does not appear to be recitation as to who or whom is making a determination or similarly processing the additional steps in claims 47-48. Appellant in independent claim 46 recites, "permitting the software application to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded." This aspect of the claimed invention appears only to be mentioned on page 3 and 7 of the appellant's disclosure. Appellant's disclosure recites, "*...After successful completion of the installation the script is marked used and cannot be used again [installation applet]. Marking of the installation script as used also disables the forwarding mechanism*

of the electronic mail software to prevent the user from accessing a second copy of the installation script or software, (page 3, lines 12 et seq.)." Plainly put, **the installation of the software prevents a second copy from being installed on a computer system. It only disables the installation script not the application software that is attached to the email.** The 112-second rejection is deemed proper, because, appellant has failed to clearly and distinctly identified what or which elements is making a determination about which program. Appellant has disclosed an installation script/ applet and an application software program. The specification only appears to disable the running of the installation script and not the software application program. **The application software is enabled and disabled via a value stored in the system's registry**, as evidenced by appellant's disclosure reciting, "When the application is launched/ [operated or run], the hard drive serial number is read from the installation machine...and compared to the value stored in the system registry. If the serial numbers match, the application is allowed to execute normally. If they do not match, the application terminates. This prevents the application from being used even if the entire hard drive image is copied to another machine, (see page 3, lines 17 et seq.)." Thus, it is the registered value not the marking of the do not forward instruction that prevents the application software from being executed or run [emphasis added]. It is the installation script that the do not forward instruction (or determination) prevents running, not the application program. The running of the application program is tied to the value stored in the register, which is based upon the system's serial number, not the do not forward instruction. Therefore, either applicant has misstated the claimed

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invention, or at the very least it is unclear what or how the do not forward command is tied to the executing of his application program, as it has been disclosed, in his specification, to be contrary to what he is suggesting as recited in his claims and appeal brief. The checking of the do not forward command before executing the software application appears to be devoid of any suggestion or explicit teaching as disclosed in the specification and drawings. Therefore, in view of the apparent contradiction, the examiner presumed in this instance that appellant's invention had as a goal: 1) a desired to have a do not forward options, and 2) a means of preventing the application software from executing on subsequent machines as recited above. With such a goal in mind the examiner applied two references that performed both of the understood features of do not forward and prevention of copying, respectively, Olkin et al. '564 and Leonard et al. '784. It appears that Appellant has recited steps or an apparatus for performing disjoint process steps, particularly, his incorporation of a two step process of determining if a do not forward has been incorporated into a script and a step for preventing the execution of an application on a subsequent machine. Stated differently, he has merged the two-step process into a single step, which has not been supported in the disclosure. The difficulty determining the metes and bounds of the claims, results from the fact that the claims appear to be indefinite and has not clearly and distinctly set forth that which appellant has regarded as his invention.

Again on page 7, of appellant's disclosure similar recitation is found regarding the features of do not forward as it applies to the installation script, and the prevention of the execution of the software application on subsequent machines, see lines 19-23 et

seq. Here appellant recites that, "the final event [step two] is the enabling the application. The installation scripts stores the encrypted hard drive serial number in the system registry.... Serial number is read from the machine and compared to the value stored in the registry... if the serial numbers match, the application is allowed to start normally." Notwithstanding, the reason recited above, equally apply to appellant's disclosure and the claimed invention with regards to page 7 of his specification.

Looking at Appellant's drawings figures 9 and 10, they plainly convey the interpretation put forth by the examiner. Figure 9, depicts the two-step process, at 108, it demonstrates the do not forward aspect of the script 102-112. Similarly, element 118 shows the encryption of the serial number hard drive, while 204-210 of figure 10 shows the comparison of the registered serial number. Appellant has recited that his claimed invention is something that is contrary to his specification, and since the drawings appear to be consistent with appellant's specification. The examiner has given the claims the broadest interpretation possible consistent with the specification, and that is, that the invention has a do not forward feature that prevents the installation script from being installed on subsequent machines, and a disabling feature for prevention the execution of the application software, i.e. based upon a registered value. The disclosure is silent and devoid of any teaching regarding the do not forward instruction preventing the execution of the software application. For the reasons recited above it is believed that the 112 rejection is proper.

As to the remarks regarding the 103 rejection, particularly claims 46-51, 64-69 and 70-75, appellant has opined that the prior art fails to teach the all of the claimed

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limitations. Appellant remarks that, permitting the software application program to run only if a determination is made that a disabling instruction has been incorporated ... that prevents forwarding, has not been taught. The examiner does not concur.

First, as indicated above in the remarks to the 112, it is not believed that appellant invention has a single step process that checks for a disabling instruction, i.e. do not forward, and if and only if it is incorporated permits the execution of the software application. Olkin et al. '564 teach, similar to appellant, a secure method (col. 14, lines 18 et seq.) of transferring an e-mail, which may contain software applications, scripts or applets contained within the body of the email (col. 8, lines 8 et seq.). It provides for authentication of the receiver and following successful authentication either automatic or user installed options for the scripting the installation process. This process may be a plug in or a script or applet separate and apart from the attachment (col. 7, lines 54-61 et seq., col. 8, lines 8 et seq., and col. 13, lines 20 et seq.). While '564 does provide for administration of maximum reads (col. 9, lines 32-35), and optional features of use permitted (col. 11, lines 19 et seq.), expiration time, number of recipients, or maximum number of deliveries (figs. 3 or 4, col. 13, lines 10 et seq.), and a reason for denial via a dialog box (col. 13, lines 40 et seq.). The '564 reference was absent any teaching of checking the e-mail for a forwarding instructions.

Leonard et al. '784 teaches an e-mail system and method for having an event, date, or time to control and track the handling of emails the messages by recipients via a viewer applet (see abs., figs. 2-7, [2, 11-12, 260, 340], figs. 12-13, control applet [12], col. 14, lines 40-56 et seq., col. 15, lines 1-10, 29-45, and col. 16, lines 12-20 and 44-

56). In column 6, lines 19-34 et seq., '784 teach the use of viewer applets for distributing e-mails and controlling them after installation of the viewer applets. He also goes further to state that his system provides for originator control over the lifespan of the message (col. 5, lines 26 et seq.), and that his invention extends the concept of supplying executable programs files communicated via e-mails (col. 6, lines 43 et seq.). One of the control features provided by '784 is the do not forward options (see fig. 5, [340], and fig. 12 [20]). A detailed description is given in col. 19-20, of particular note is the use of lifespan control printing, permitting or prohibiting of alterations and forwarding (col. 19, line 55-67, col. 20 lines 1-14, and 50-65, col. 21, lines 1-10, and col. 22, lines 28-45 et seq.). Appellant asserts that there is no reason to combine the prior art, the examiner does not concur. '564 teach an email system for securing emails and their attachments (programs) following installation of a script, applet or program. '564 provides a flexible and convenient way of registering and controlling or running software modules following authentication and installation of plug-in, script, or applets (col. 18, lines 44 et seq.). Furthermore, the invention is easily incorporated into existing systems utilized on the internet (col. 19, lines 26 et seq.). Leonard '784 teaches a way of controlling e-mail attachment via lifespan controls, notably the do not forward feature (fig. 5 and 14). '784 is also not limited to any particular e-mail system and maybe implemented in existing systems (col. 7, lines 5-20). Similarly, his system is also implemented following a success installation of a viewer program, script, or applet (col. 19, lines 55 et seq., and col. 22, lines 28 et seq.). Therefore, it is believed that since both inventions are from the same field of endeavour, and are both are generally

concerned with the security of e-mails and their attachments. Namely, the restriction and control on the use of e-mail attachments following an installation process. Furthermore, since both '784 and 564 are not restricted to any particular e-mail system and are both designed to be readily implemented into any existing system. It is believed, as recited in the office action that, a person of ordinary skill in the art would have look to the invention of '784 as an added means of protecting the security and control of an attachment from unauthorized access or transferral. Both have suggested that other control options are available and could readily be implemented.

As to the remarks regarding the pre-specified e-mail server being taught, both teach this feature. '564 utilizes an encryption scheme for ensuring that only a specified user receives and utilizes the e-mail by requiring the use to have a key or pre-register (see col. 4, lines 1-44, and col. 6, lines 29 et seq., and figs. 1 and 4). '784 teach the features at figures 1-3, and 16, and col. 13, lines 5-14 et seq.. The claimed limitation regarding a specified server only requires a server provides the e-mail to a receiving computer; both clearly perform that function as claimed.

As to the remark that neither reference teach if the e-mail is not saved by the computer discontinuing the installation process. If the e-mails were not saved then the recipient would not receive it. Stated differently, the whole process of receiving e-mail for verification and subsequently installation is built on the fact that the email is has been received (i.e. buffered, stored, or at least in your inbox). The examiner was trying to clarify by saying that the prevention of installation based upon a determination that email is not stored is not taught. Here in both examples of the prior art '784 and '564,

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their inventions would not even begin to work if the email was not received by the recipient and stored or buffered on their computer system/network. Recall, that it is the encrypted e-mail that is check and verified before the installation process even begins. It is inherent that it has been saved or else the viewer, script, or installation applet would not have been decrypted, from the body of the email, and utilized to decrypt the contents for which the viewer is provided. Notwithstanding, this is not a patentable distinction, just a difference in wording. The examiner is perplexed by the remarks, that an email determination must be made with regards to storage, or else it will discontinue installation of the program that is contained within the email. Keep in mind that it is the email that contains the program for execution that is going to be installed. Moreover, all executable instruction or program requires storage or buffering before executable program may be executed via a processor. Here there is a clear showing that the viewer applet or script is the program code that must be installed prior to the installation of the application program also contained within the program. Therefore, if one did not save the email, then one would not have access to the applet or script to install and decode the application program contained within the email. Program must inherently be buffered or stored prior to execution, and emails must be received and stored prior to their use, especially if they contain an executable program. It is believed that no additional reference is required, as it is illogical for the recited functions to occur in the context of the claimed invention. That is it is not understood how an unsaved e-mail could execute the installation of a program it contains if it is not stored. Notwithstanding '784 teaches special handling instruction as part of the installation process

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see col. 18, lines 16-40, if a failure occurs during the installation of the viewer the whole process is deleted, or the email message is deleted. Therefore, an unsuccessfully saved email would logically result in termination of the installation program that is contained within the email, because the code necessary for installation would not be able to be retrieved by the executing processor.

As to the remarks regarding the use of comparing the serial number of a computer for gaining access to a program, the examiner again disagrees with appellant. First, official notice was taken of this feature in an office action dated 1/31/2005, see below: The examiner takes official notice of both the motive and modification necessary for having a local processor store its identifying information/serial number/machine identity in an encrypted registry as part of a validation/installation process. '564 is being recited as support for the taking of official notice, see fig. 5, col. 8, lines 40-45 et seq., and lines 60-67 et seq., col. 10, line 25 et seq. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the installation and verification processes of '784 with an applet subroutine as taught by '564, for enabling the installation and verification process to having a registry that has identifying information that is machine or computer specific and dependent. One of ordinary skill in the art would have been motivated to perform this modification, because, one would have had a desire to ensure, that after supplying a secured e-mail or application, that the data or program was not inappropriately stored or used on a machine for which it was not intended. A person of ordinary skill would have chosen this or any other well proven method of protecting data as a means of providing additional steps in protecting

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their data or program, as suggest by "784 at abs., col. 1, lines 20-45, col. 3, lines 50 et seq., and col. 6, lines 20-34. '564 also indicates that the user may have various installable options associated with an applet to permit registration, see '564 at col. 4, lines 35 et seq., col. 6, lines, 13 et seq., and col. 8, lines 17-27 and 40-65 et seq.

This taking of official notice was not seasonably challenged in the next official correspondence to the office, and the claimed limitation were cancelled from claims 1-45 and reinstated in the pending claims (i.e. claim 61). This lack of challenged is viewed to be an admission of appellant and now he wishes to reassert that it is not well known in the art. If it was notoriously well known in the previous office action is still well known in this office action, accordingly any further proof of its veracity is not deemed necessary.

As to the remarks that the installation can occur only once and the prior art has not taught this feature, the examiner does not agree.

Specifically, '564 teaches an enabling mechanism for single use key and any arbitrary number of installation, specifically, "the maximum number of times that each receiver open and read a secure e-mail [thus install or use]" see col. 9, lines 33 et seq. "A default may be zero, meaning that there is no limit," col. 9, lines 36 et seq., see also figs 3, 6a-6c. Similarly, 784 teach a read once option, see figs. 4 (280) and 5 (260), which has been grossly incorporated into the rejection.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

Norman Wright


NORMAN M. WRIGHT
PRIMARY EXAMINER

Conferees:

Gilberto Barron


SPE 2132

Matthew Smithers

